

## **REMARKS**

Reconsideration of this application, as amended, is respectfully requested.

Initially, the Applicants would like to thank the Examiner for the indication that claims 9, 11, 14, and 16 contain allowable subject matter. Thus, claims 9, 11, 14 and 16 have been amended to rewrite the same in independent form including the limitations of the base claim and any intervening claim. However, the base claims incorporated into claims 9, 11, 14 and 16 have been rewritten to address the Examiner's rejection thereof under 35 U.S.C. § 112, second paragraph.

In the Official Action, the Examiner rejects claims 1, 7, 12, 17, and 18 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner argues that the claims are indefinite and do not conform to U.S. practice.

In this regard, claims 1, 7, 12, 17, and 18 have been rewritten to clarify the same and to conform to U.S. practice and style. Independent claim 19 has also been amended. Further, dependent claims 2, 6, 8, 10, 13, and 15 have been amended to be consistent with their amended base claim and/or to also clarify the same and to conform to U.S. practice and style. The amendments to the claims are fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of such amendments.

In the Official Action, the Examiner rejects claims 1-8, 10, 12, 13, 15, 19, and 20 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. 2003/0117491 to Avni et al., (hereinafter "Avni"). Furthermore, the Examiner rejects claims 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Avni in view of European Patent No. 0912047 to Matsumoto et al., (hereinafter "Matsumoto").

In response, as discussed above, independent claims 1, 7, 12, 18, and 19 have been amended to clarify their distinguishing features.

Turning now to the prior art, Avni discloses that the illumination luminance is detected by the illumination sensor for irradiation of the illumination (and photographing) and the continuous photographing is performed while adjusting so that the next illumination may become proper. Thus, the photographing is performed while adjusting the image.

In stark contrast, the claims recite that the illuminating light is irradiated with a determined pattern (e.g., alternately) of the preset conditions (e.g., the light-emitting amount and the light-emitting time) and the image obtained as the result thereof is selected later.

Thus, in Avni, the photographing is apt to be performed only with a predetermined luminance depending upon the status of sensing. Such a disadvantage is overcome in the capsule endoscope apparatus as recited in the claims because the switching is preset.

With regard to the rejection of claims 1-8, 10, 12, 13, 15, 19, and 20 under 35 U.S.C. § 102(e), a capsule endoscope apparatus having the features discussed above and as recited in independent claims 1, 7, 12 and 19, is nowhere disclosed in Avni. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”<sup>1</sup> independent claims 1, 7, 12 and 19 are not anticipated by Avni. Accordingly, independent claims 1, 7, 12, and 19 patentably distinguishable over Avni and are allowable. Claims 2-8, 13, 15, and 20 being dependent upon claims 1, 7, 12, and 19, are thus at least allowable therewith. Consequently, the

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<sup>1</sup> Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

Examiner is respectfully requested to withdraw the rejection of claims 1-8, 10, 12, 13, 15, 19, and 20 under 35 U.S.C. § 102(e).

With regard to the rejection of claims 17 and 18 under 35 U.S.C. § 103(a), Independent claims 17 and 18 are not rendered obvious by the cited references because neither the Avni patent nor the Matsumoto patent, whether taken alone or in combination, teach or suggest a capsule endoscope apparatus having the features described above. Accordingly, claims 17 and 18 patentably distinguish over the prior art and are allowable. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 17 and 18 under 35 U.S.C. § 103(a).

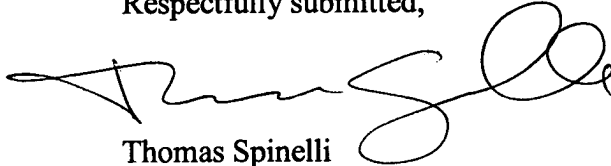
Furthermore, new claims 21 and 22 have been added to further define the patentable invention. New claims 21 and 22 are fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the addition of new claims 21 and 22. Applicants respectfully submit that new claims 21 and 22 are at least allowable as depending upon an allowable base claim (1).

Lastly, while reviewing the specification, Applicants noticed an error at page 15 and have corrected the same in response to the Official Action. Specifically, "stuff" at line 12 of page 15 has been changed to --staff--. No new matter has been entered into the disclosure by way of such correction.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone

conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Thomas Spinelli', with a large, stylized flourish at the end.

Thomas Spinelli  
Registration No. 39,533

Scully, Scott, Murphy & Presser  
400 Garden City Plaza  
Garden City, New York 11530

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